



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/866,543	05/25/2001	David E. Patterson	3017-56	6399

7590

09/02/2003

LAURENCE A. WEINBERGER
SUITE 103
882 S. MATLACK ST.
P.O. BOX 1663
WEST CHESTER, PA 19380-0053

EXAMINER

ZEMAN, MARY K

ART UNIT

PAPER NUMBER

1631

8

DATE MAILED: 09/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/866,543

Applicant(s)

PATTERSON ET AL.

Examiner

Mary K Zeman

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 4-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☒ Claim(s) 1-3 is/are objected to.
- 8) ☒ Claim(s) 1-9 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 1631

DETAILED ACTION

The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 1631, Examiner Mary K Zeman.

Claims 1-9 are pending in this application.

Election/Restrictions

Applicant's election with traverse of Group I, claim 1 in Paper No. 7 is acknowledged. The traversal is on the ground(s) that Groups II and II are not patentably distinct, and are merely variants of one another. These arguments are persuasive, and claims 2 and 3 are rejoined. Applicant presents no argument to the remaining groups.

The requirement is still deemed proper for the remaining groups and is therefore made FINAL.

Priority

Priority to 3 separate US Applications is acknowledged.

Information Disclosure Statement

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Drawings

The drawings filed with the application are acceptable to the examiner. If any changes in the drawings were made in parent application 08/903217 that are not reflected in the current set of drawings, those proposed changes must be included in the response to this action.

Art Unit: 1631

Specification

The disclosure is objected to because of the following informalities: the brief description of the drawings at pages 15-16 do not address each portion of each figure individually, as required. If a figure has three parts (for example if Figure 11 consisted of Figure 11 (a), (b) and (c)) that figure must be referred to as "Figures 11 (a)-(c) are graphs representing..."

Appropriate correction is required.

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: Virtual library of possible combinatorially derived product molecules.

Claim Objections

Claims 1-3 are objected to because of the following informalities: the claim should end with a single period. Each step in the claim should not have a period- to differentiate between the letter of the step and the beginning of the step, one could use the following format: "a)" or "a:" or "(a)". Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-3 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are drawn to nonfunctional descriptive material. The claims are drawn to data representations of a virtual library of molecules that is comprised of characterization data, structural variation, combinatorial reactions and molecular descriptors. These libraries are mere presentations of information or abstract ideas which have not been practically applied. (see, e.g., *In re Warmerdam*, 33 F.3d 1354, 1361, 31 USPQ 2d 1754, 1760 (Fed. Cir. 1994) (descriptive material *per se* is not patent eligible subject matter). No physical molecules are actually created or synthesized, and the data generated by the computer

Art Unit: 1631

implemented method is merely a list of data structures meeting particular limitations and thresholds. See also the Report on Comparative Study in New Technologies Carried Out Under Trilateral Project WM4 accessible on the World Wide Web at:

http://www.uspto.gov/web/tws/wm4/wm4_index.htm

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Cramer, III (USP 5,307,287).

The claims are drawn to data representations (virtual libraries) of selected molecules, those molecules being selected by a particular set of characterized data. These are product-by-process claims drawn to nonfunctional descriptive material. Cramer, III (USP 5,307,287- of record in 08/592132) discloses virtual libraries of molecules that could be created wherein the libraries comprise information about the possible structures such as molecular descriptors, characterization data, and common core features. As such, this disclosure provides the same non-functional descriptive material as that being claimed.

Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Agrafiotis et al. (5,463,564)

The claims are drawn to data representations (virtual libraries) of selected molecules, those molecules being selected by a particular set of characterized data. These are product-by-process claims drawn to nonfunctional descriptive material. Agrafiotis (USP 5,463,564- of record in 08/592132) discloses virtual libraries of molecules that could be created wherein the

Art Unit: 1631

libraries comprise information about the possible structures such as molecular descriptors, characterization data, and common core features. As such, this disclosure provides the same non-functional descriptive material as that being claimed.

Conclusion

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary K Zeman whose telephone number is (703) 305-7133.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, can be reached at (703) 308-4028.

The Official fax numbers for this Art Unit is: (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC1600 Receptionist whose telephone number is (703) 308-0196.

mkz

8/27/03


MARY K. ZEMAN
PRIMARY EXAMINER
